

REMARKS

Response to Priority

The Examiner contends that some of the pending claims do not have support in the parent application, 09/241,936 now U.S. Patent No. 6,161,034. Applicants's amendments to the claims require a tubular member with a ramp which is not disclosed in the aforesaid earlier filed application. Other features are likewise not found in the aforesaid earlier filed application. Applicants hereby withdraw their claim for priority based upon the aforesaid earlier filed application.

Response to Claim Objections

Claim 111 was objected to by the Examiner under 37 C.F.R. §1.75 as being a substantial duplicate of claim 66.

Applicants have cancelled claim 66 without prejudice so this objection is moot.

Claim 74 was objected to by the Examiner because of the following informalities: the limitation "at least one marker body" should read -- at least one radiographically detectable marker body --.

Applicants have amended claim 73 (from which claim 74 depends) so this objection is moot.

Claim 112 was objected to by the Examiner because it recites the limitation "5-10 mm" in line that should read -- 5 to 10 mm --.

Applicants have amended claim 112 as suggested by the Examiner.

Response to Claim Objections and Rejections under 35 USC §112

Claims 66, 68, 69, 71, 73-86 and 11-113 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In response, Applicants have cancelled claim 66, amended many of the other aforesaid claims to obviate this rejection.

Response to Claim Rejections under 25 U.S.C. §103

Claims 66, 68, 69, 71 and 111-113 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Foerster et al. (U.S. Pat. No. 6,228,055) in view of Voegele et al. (U.S. Pat. No. 6,261,302), Fulton, III et al. (U.S. Pat. No. 6,270,464), Li (U.S. Pat. No. 6,350,274) and Ronan et al. (U.S. Pat. No. 5,820,918).

Claim 66 has been cancelled without prejudice but applicants will address this rejection as if were applied to new claim 114. In the aforesaid rejection the Examiner contends that Voegele et al. teaches a ramp within the cannula of a biopsy marker delivery tool configured to urge a marker body of the discharge port into the biopsy cavity. The reference does not teach this feature as contended by the Examiner. Specifically, Voegele et al. teaches a ramp to guide a marker delivery tube to a location outside of a discharge port. The applicants believe that the Examiner is misconstruing the reference. The egress ramp (65) of Voegele et al. has no function of changing the position of a marker body within a marker delivery tube, nor would the reference suggest to those skilled in the art to put a ramp within a marker delivery tube. Voegele et al. would teach those skilled in the art to employ yet another tubular member with a ramp to guide a marker delivery tube out of the yet another tubular member.

To clarify this issue, applicants have added new claim 114 which requires the marker to be positioned within the inner lumen of the delivery cannula at a location proximal to the elongated discharge port and a plunger within the inner lumen which slidably advances the marker body from the location proximal to the discharge port into engagement with the ramp, up the ramp and out of the discharge port.

The Examiner's hindsight use of applicants' specification is not appropriate. The marker of Voegele et al. is fixed within the flexible tube (37) until the distal end of the flexible tube is out of the egress tube (63) so the marker is not slidably advanced from a location proximal to the discharge port in the egress tube 63.

The Examiner states that the configuration of Voegele et al. provides that ability to eject

the marker cannula for implantation in the tissue in a direction substantially perpendicular to the longitudinal movement of the ejector to increase the accuracy and placement of the marker into the biopsy sight. As shown in Figures 21 and 28 of Voegele et al. the marker 31 is not released until the marker is distal to the distal end of egress tube 63. Voegele et al. clearly does not eject the marker cannula perpendicular to the longitudinal movement of the ejector as contended by the Examiner.

Applicants believe that the Examiner has put forth a make-weight argument based upon hindsight with applicants' specification which has no support in the cited references. The Examiner misconstrues movement of a marker cannula with movement of a marker.

Thus, the combination of references do not teach what the Examiner contends and they do not support the Examiner's rejections of applicants' claims.

Claims 73-75, 85 and 86 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Foerster et al. ('055) in view of Voegele et al. ('302), Fulton, III et al. ('464), Li ('274) and Ronan et al. ('918) as applied to claims 66, 68, 69, 71 and 111-113 above, and further in view of Sirimanne et al. (U.S. Pat. No. 6,356,752).

Claims 76-84 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Foerster et al. ('055) in view of Voegele et al. ('302), Fulton, III et al. ('464), Li ('274) and Ronan et al. ('918) as applied to claims 66, 68, 69, 71 and 111-113 above, and further in view of Yamamoto (U.S. Pat. No. 4,847,049), as evidenced by Ronan et al. ('918).

Claims 66, 68, 69, 73-75, 85, 86 and 111-113 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Foerster et al. ('055) in view of Voegele et al. ('302), Sirimanne et al. ('782), Li ('274) and Ronan et al. ('918).

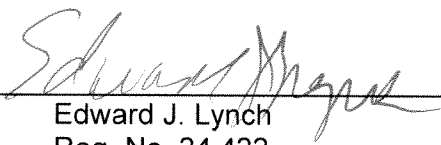
Claims 76-84 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Foerster et al. ('055) in view of Voegele et al. ('302), Sirimanne et al. ('782), Li ('274) and Ronan et al. ('918) as applied to claims 66, 68, 69, 73-75, 85, 86 and 111-113 above, and further in view of Yamamoto ('049), as evidenced by Ronan et al. ('918).

All of the aforesaid rejections are subject to the same problems with respect to the teachings of Voegelé et al. and should be withdrawn.

Conclusions

Applicants believe that the pending claims define patentable subject matter. Further consideration pursuant to the concurrently filed RCE and an early allowance are earnestly solicited.

Respectfully submitted,

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